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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/837,396      | 04/18/2001  | Frank R. Callaghan   |                     | 7653             |

7590 07/28/2004  
Frank R. Callaghan  
337 Fairway Road  
Ridgewood, NJ 07450

EXAMINER

YOUNG, JOHN L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3622

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/837,396

Applicant(s)

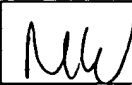
CALLAGHAN ET AL.

Examiner

John L Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

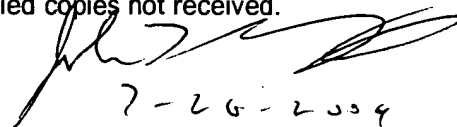
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

  
7-26-2004**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **FIRST ACTION REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS - 35 U.S.C. 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process,  
machine, manufacture, or composition of matter or any new  
and useful improvement thereof, may obtain a patent  
therefore, subject to the conditions and requirements of this  
title.

2. Claims 1-15 are rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

As per claims 1-15, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172

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(CCPA 1974) also see MPEP 2106 IV 2(b) even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999) within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05( q )).

### **DOMESTIC PRIORITY NOT GRANTED**

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119( e ), because there appears to be NO claim for domestic priority based on a provisional application, and provisional application 60/199,061 fails to provide adequate support under 35 U.S.C. 112 for claims 1-21 in the instant application. It appears that the provisional application does not contain a written

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specification.

### CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schramm US 2001/0031458 A1; class 435/350, (10/18/2001) [US f/d: 05/01/2001] (herein referred to as “Schramm”).

As per claim 1, Schramm (the ABSTRACT; FIG. 2; FIG. 3; FIG. 5; FIG. 6; ¶[0007]; ¶[0008]; ¶[0013]; ¶[0015]; ¶[0023]; ¶[0046]; ¶[0062]; ¶[0063]; ¶[0064]; and ¶[0066]) shows: “A method of maximizing educational enrollments, comprising . . .

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generating a database containing a plurality of Members in communication with a controller; and . . . receiving data at said controller on at least one Network School offering a discount tuition rate in exchange for access to said Members.”

Schramm lacks explicit disclosure of “at least one Network School. . . .” even though Schramm (FIG. 2; and FIG. 6) implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schramm (FIG. 2; and FIG. 6) implicitly shows “at least one Network School. . . .” and it would have been obvious to modify and interpret the disclosure of Schramm cited above as showing “at least one Network School. . . .” because modification and interpretation of the cited disclosure of Schramm would have provided means to “*assist colleges in their methods of identifying, recruiting, and retaining high school students.*” (See Schramm (¶[0013]), based on the motivation to modify Schramm so as to “*help students, schools, and colleges accomplish their share goal: to match as many students as possible with the colleges where they will thrive.*” (See Schramm (¶[0008])).

As per claims 2-7, Schramm shows the method of claim 1 and subsequent base claims depending from 1.

Schramm (the ABSTRACT; FIG. 2; FIG. 3; FIG. 5; FIG. 6; ¶[0007]; ¶[0008]; ¶[0013]; ¶[0015]; ¶[0023]; ¶[0046]; ¶[0062]; ¶[0063]; ¶[0064]; and ¶[0066]) implicitly shows the elements and limitations of claims 2-7.

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Schramm lacks explicit recitation of the elements of claims 2-7, even though Schramm implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schramm (FIG. 2; and FIG. 6) implicitly shows the elements and limitations of claims 2-7 and it would have been obvious to modify and interpret the disclosure of Schramm cited above as showing the limitations of claims 2-7 because modification and interpretation of the cited disclosure of Schramm would have provided means to “*assist colleges in their methods of identifying, recruiting, and retaining high school students.*” (See Schramm (¶[0013]), based on the motivation to modify Schramm so as to “*help students, schools, and colleges accomplish their share goal: to match as many students as possible with the colleges where they will thrive.*” (See Schramm (¶[0008])).

Independent claim 8 is rejected for substantially the same reasons as independent claim 1.

As per claim 9, Schramm shows the method of claim 8.

Schramm (the ABSTRACT; FIG. 2; FIG. 3; FIG. 5; FIG. 6; ¶[0007]; ¶[0008]; ¶[0013]; ¶[0015]; ¶[0023]; ¶[0046]; ¶[0062]; ¶[0063]; ¶[0064]; and ¶[0066]) implicitly shows the elements and limitations of claim 9.

Schramm lacks explicit recitation of the elements of claim 9, even though

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Schramm implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schramm (FIG. 2; and FIG. 6) implicitly shows the elements and limitations of claim 9 and it would have been obvious to modify and interpret the disclosure of Schramm cited above as showing the limitations of claim 9 because modification and interpretation of the cited disclosure of Schramm would have provided means to *“assist colleges in their methods of identifying, recruiting, and retaining high school students.”* (See Schramm (§[0013]), based on the motivation to modify Schramm so as to *“help students, schools, and colleges accomplish their share goal: to match as many students as possible with the colleges where they will thrive.”* (See Schramm (§[0008])).

Independent claim 10 is rejected for substantially the same reasons as independent claim 1.

Independent claim 11 is rejected for substantially the same reasons as independent claim 1.

As per claims 12-14, Schramm shows the method of claim 11.

Schramm (the ABSTRACT; FIG. 2; FIG. 3; FIG. 5; FIG. 6; §[0007]; §[0008]; §[0013]; §[0015]; §[0023]; §[0046]; §[0062]; §[0063]; §[0064]; and §[0066]) implicitly



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shows the elements and limitations of claims 12-14.

Schramm lacks explicit recitation of the elements of claims 12-14, even though Schramm implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schramm (FIG. 2; and FIG. 6) implicitly shows the elements and limitations of claims 12-14 and it would have been obvious to modify and interpret the disclosure of Schramm cited above as showing the limitations of claims 12-14 because modification and interpretation of the cited disclosure of Schramm would have provided means to *“assist colleges in their methods of identifying, recruiting, and retaining high school students.”* (See Schramm (¶[0013]), based on the motivation to modify Schramm so as to *“help students, schools, and colleges accomplish their share goal: to match as many students as possible with the colleges where they will thrive.”* (See Schramm (¶[0008])).

Independent claim 15 is rejected for substantially the same reasons as independent claim 1.

Independent claim 16 is rejected for the same reasons as independent claim 1.

As per claims 17-18, Schramm shows the system of claim 16.

Schramm (the ABSTRACT; FIG. 2; FIG. 3; FIG. 5; FIG. 6; ¶[0007]; ¶[0008];

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¶[0013]; ¶[0015]; ¶[0023]; ¶[0046]; ¶[0062]; ¶[0063]; ¶[0064]; and ¶[0066]) implicitly shows the elements and limitations of claims 17-18.

Schramm lacks explicit recitation of the elements of claims 17-18, even though Schramm implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schramm (FIG. 2; and FIG. 6) implicitly shows the elements and limitations of claims 17-18 and it would have been obvious to modify and interpret the disclosure of Schramm cited above as showing the limitations of claims 17-18 because modification and interpretation of the cited disclosure of Schramm would have provided means to “*assist colleges in their methods of identifying, recruiting, and retaining high school students.*” (See Schramm (¶[0013]), based on the motivation to modify Schramm so as to “*help students, schools, and colleges accomplish their share goal: to match as many students as possible with the colleges where they will thrive.*” (See Schramm (¶[0008])).

Independent claim 19 is rejected for substantially the same reasons as independent claim 1.

As per claim 20, Schramm shows the system of claim 19.

Schramm (the ABSTRACT; FIG. 2; FIG. 3; FIG. 5; FIG. 6; ¶[0007]; ¶[0008]; ¶[0013]; ¶[0015]; ¶[0023]; ¶[0046]; ¶[0062]; ¶[0063]; ¶[0064]; and ¶[0066]) implicitly

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shows the elements and limitations of claim 19.

Schramm lacks explicit recitation of the elements of claim 19, even though Schramm implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schramm (FIG. 2; and FIG. 6) implicitly shows the elements and limitations of claim 19 and it would have been obvious to modify and interpret the disclosure of Schramm cited above as showing the limitations of claims 19 because modification and interpretation of the cited disclosure of Schramm would have provided means to *“assist colleges in their methods of identifying, recruiting, and retaining high school students.”* (See Schramm (§[0013]), based on the motivation to modify Schramm so as to *“help students, schools, and colleges accomplish their share goal: to match as many students as possible with the colleges where they will thrive.”* (See Schramm (§[0008])).

Independent claim 21 is rejected for substantially the same reasons as independent claim 1.

## CONCLUSION

5. Any response to this action should be mailed to:

Commissioner for Patents  
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Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at

(703) 305-3801. The examiner can normally be reached Monday through Friday

between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

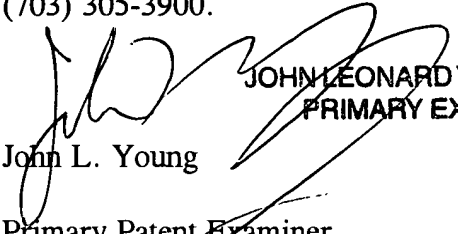
Serial Number: 09/837,396

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

 **JOHN LEONARD YOUNG, ESQ.**  
**PRIMARY EXAMINER**  
John L. Young  
Primary Patent Examiner

July 26, 2004